

REMARKS/ARGUMENTS

Claims 1-3, 5-7, 9-11, 16-17 and 22-24 are pending in the present application. Claims 5 and 23 have been amended herewith. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 103, Obviousness

Claims 1-3, 9-11, 16-17 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Crawford (U.S. Patent No. 6,781,608), hereinafter “Crawford” and Hackbarth et al. (U.S. Patent No. 7,107,312), hereinafter “Hackbarth”. This rejection is respectfully traversed.

Per MPEP 2143.03, to establish prima facie obviousness of a claimed invention, *all of the claim limitations* must be taught or suggested by the prior art. Applicant will now show that all of the claim limitations recited in these Claims 1-3, 9-11, 16-17 and 22 are not taught or suggested by the cited references. Accordingly, a proper prima facie case of obviousness has not been established by the Examiner, and thus these Claims 1-3, 9-11, 16-17 and 22 have been erroneously rejected due to such prima facie deficiency¹.

With respect to Claim 1, such claim recites “*responsive to receiving* an instant message, determining whether a picture image of a sender of the instant message is associated with the instant message” (emphasis added). In rejecting Claim 1, the Examiner states:

“Regarding claims 1 and 10, Crawford teaches responsive to receiving an instant message, determining whether a picture image of a sender of the instant message is associated with the instant message, *taught as the sending of an instant message that includes a picture* (buddy icon) of the sender, at col. 14, lines 54-60.”

Applicant respectfully submits that an action of *sending of an instant message* does not teach or otherwise suggest any actions associated with *receiving of an instant message*. During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). This means that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below);

¹ If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Chef America, Inc. v. Lamb-Weston, Inc., 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004) (Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed **to mean exactly what they say**. Thus, "heating the resulting batter-coated dough to a temperature in the range of about 400°F to 850°F" required heating the dough, rather than the air inside an oven, to the specified temperature.) MPEP 2111.01(I) (emphasis added by Applicant). The Examiner is not interpreting the claim terms in accordance with their normal, plain meaning. For example, the term ‘sending’ is defined by The American Heritage® Dictionary of the English Language, Fourth Edition² to mean:

send, sent, send·ing.

–verb (used with object)

1. to cause, permit, or enable to go: *to send a messenger; They sent their son to college.*
2. to cause to be conveyed or transmitted to a destination: *to send a letter.*
3. to order, direct, compel, or force to go: *The president sent troops to Asia.*
4. to direct, propel, or deliver to a particular point, position, condition, or direction: *to send a punch to the jaw; The punch sent the fighter reeling.*

In contrast, the term ‘receiving’ is defined by this same American Heritage Dictionary to mean:

re·ceive , -ceived, -ceiv·ing.

–verb (used with object)

1. to take into one's possession (something offered or delivered): *to receive many gifts.*
2. to have (something) bestowed, conferred, etc.: *to receive an honorary degree.*
3. to have delivered or brought to one: *to receive a letter.*
4. to get or be informed of: *to receive instructions; to receive news.*

It is respectfully submitted that ‘sending’ and ‘receiving’ are not equivalent or synonymous terms – and in fact could reasonably be interpreted to mean exactly the opposite thing from one another – and thus an allegation of an action associated with ‘sending’ an instant message does not establish any

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teaching or suggestion with respect to ‘receiving’ an instant message, such as the claimed feature of “*responsive to receiving* an instant message, determining whether a picture image of a sender of the instant message is associated with the instant message”. As but one example, in an instant message system there is no guarantee that something that is sent is even received at the other end. Thus, the Examiner has failed to establish a prima facie showing of obviousness, and accordingly the burden has not shifted to Applicant to rebut this improper obviousness assertion³.

Further with respect to Claim 1, there would be no reason for Crawford to perform any picture image association determination in response to receiving an instant message, as a buddy icon is always imbedded within a received message and is displayed along with the text message using normal display techniques where the data that is received is displayed (Crawford Figure 7, block 750a).

Still further with respect to Claim 1, such claim recites “wherein the picture image of the sender is located in at least one of a local cache on the data processing system and a preexisting database of pictures on a remote data processing system *as determined by a user selected preference*”. As can be seen, the location of the sender picture image is determined by a user selected preference. In rejecting this aspect of Claim 1, the Examiner acknowledges that Crawford does not teach this claimed feature, but goes on to state that Hackbarth teaches such user selected preference of the sender picture image at Hackbarth col. 6, lines 18-40; col. 16, lines 31-44, col. 10, lines 63-67; and col. 5, lines 6-34. Applicant urges error, as none of this cited passages teach or otherwise suggest using a user selected preference in determining the location of the sender picture image, as will now be shown in detail.

Per Hackbarth’s teaching at the cited passage at col. 6, lines 18-40, there Hackbarth states:

A ConnectIcon View 215 is a virtual entity stating one user's desire to connect to one or more other users. The ConnectIcon View 215 data is stored in the User Agent 203 LDAP database 206 and is made visible in the user's browser in a ConnectIcon View 215. This provides a representation of each other participant's presence status and enables the participants receiving the data to contact each other via clicking. A user configures and sends a ConnectIcon View using servlets of the User Agent 203. ConnectIcon Views may include pointers to documents, notes, calendars and connection processes such as chat, voice, conference and application sharing. Specifically, a ConnectIcon View 215 is a dynamic visual representation of the participants of a group being invited to communicate together with their presence information, lists of documents and URLs (Uniform Resource Locators) to be examined, and a set of mechanisms (email, chat, voice, and the like) to initiate communication, each of which can be billed to the originator. The available presence information enables a user to employ the best mode of communicating for the instant purpose, namely, either asynchronous communication or synchronous.

³ In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.*

As can be seen, this ConnectIcon view contains (1) a representation of the participants of a group being invited to communicate together, (2) presence information (which describes where and how the users are present in the network (col. 5, lines 20-23), (3) lists of documents and URLs to be examined, and (4) a set of mechanisms to initiate communication (including chat). Notably absent in this cited passage is any mention or discussion of any type of a picture image of a sender. Thus, this cited passage does not teach or otherwise suggest “wherein the *picture image of the sender* is located in at least one of a local cache on the data processing system and a preexisting database of pictures on a remote data processing system *as determined by a user selected preference*”, as there is no mention of a sender picture image in this cited passage. Therefore, the Hackbarth cited passage at col. 6, lines 18-40 does not teach or suggest “wherein the picture image of the sender is located in at least one of a local cache on the data processing system and a preexisting database of pictures on a remote data processing system *as determined by a user selected preference*”.

As to the Hackbarth cited passage at col. 16, lines 31-44, there Hackbarth states:

The ConnectIcon View 215 gives a list of views of individual ConnectIcon Views, and may be scrolled when the list is large. Each ConnectIcon View is drawn as follows: 1) **An image 905 of each person on the list of recipients** (the person's unique_id is taken from the "people" table 428, and **the image file corresponding to that person is retrieved from a WEB location storing those named files**) is drawn side by side. The image is surrounded by a border 907 that encodes the presence data for that person. In this example implementation, the border is drawn with a color that encodes the most recent device information we have for that person using the same color system as in the PeopleView 419.

While this passage makes mention of a person's image and an image file corresponding to the person, this cited passage merely describes the display of multiple images *for each person on a list of recipients*, and that image files are *retrieved from a Web location*. This cited passage does not teach or otherwise suggest “wherein the *picture image of the sender* is located in at least one of a local cache on the data processing system and a preexisting database of pictures on a remote data processing system *as determined by a user selected preference*”. The cited passage is silent as *how* the determination is made as to where the images are located, and it certainly does not teach *a user selected preference* being used for such determination. Therefore, it has been shown that the Hackbarth cited passage at col. 16, lines 31-44 does not teach or suggest “wherein the picture image of the sender is located in at least one of a local cache on the data processing

system and a preexisting database of pictures on a remote data processing system *as determined by a user selected preference*".

As to the Hackbarth cited passage at col. 10, lines 63-67, there Hackbarth states:

'getImage' is called to retrieve an image of the user. This image is stored in the table 'people' as an extra column. In this example implementation the images are stored as raw data defining a JPEG image and are retrieved and stored as standard Java Image objects.

This cited passage describes particular details associated with how an image is actually stored (in an extra column of a table, and that a particular routine (getImage) is called to retrieve an image). This cited passage does not teach or suggest "wherein the *picture image of the sender* is located in at least one of a local cache on the data processing system and a preexisting database of pictures on a remote data processing system *as determined by a user selected preference*", as there is no mention of any user selected preference associated with a sender picture image. Therefore, it has been shown that the Hackbarth cited passage at col. 10, lines 63-67 does not teach or suggest "wherein the picture image of the sender is located in at least one of a local cache on the data processing system and a preexisting database of pictures on a remote data processing system *as determined by a user selected preference*".

As to the Hackbarth cited passage at col. 5, lines 6-34, there Hackbarth states:

User Agent 203 is central to the provision of collaborative services. User Agent 203 is responsible for maintaining presence data, i.e., information, for the registered clients. It maintains lists of subscribers and notifies subscribers of changes in status. The User Agent 203 maintains a LDAP database 206 in which presence information is maintained for each individual registered with the system. It also supports Presence Clients that register with it. These clients include TeamPortal View 214, ConnectIcon View 215, and OpenChannel View 217. Presence Clients are Java classes that run remotely and can both report changes in presence status and react to User Agent messages telling them that the Presence information has changed for a user they have defined as being in their awareness set.

Briefly, the User Agent 203 is a WEB interface to a database that stores information, i.e., presence information, on users that describes where and how the users are present in the network. This information can be used to indicate availability and the best way to contact, i.e., the best mode of communicating with, a user. Access to presence information is restricted based on user preferences that are stored in the User Agent 203. The User Agent 203 uses a LDAP database 206 to store the data, but direct access to the database is not necessary. Servlets in the User Agent 203 are used to request that presence data be created or changed and to request data or subscribe to presence data (a subscription to presence data means that the subscriber is notified when that data changes).

As can be seen, this passage is directed to a description of “presence data” that is used to indicate *user availability* and the *best mode of communicating* with a user. Notably absent in this cited passage is any mention or discussion of any type of user image. Thus, this cited passage does not teach or otherwise suggest “wherein the *picture image of the sender* is located in at least one of a local cache on the data processing system and a preexisting database of pictures on a remote data processing system as determined by a user selected preference”, as there is no mention of a sender picture image in this cited passage. Therefore, it has been shown that the Hackbarth cited passage at col. 5, lines 6-34 does not teach or suggest “wherein the picture image of the sender is located in at least one of a local cache on the data processing system and a preexisting database of pictures on a remote data processing system *as determined by a user selected preference*”.

It is thus further urged that the Examiner has failed to properly establish a prima facie showing of obviousness with respect to Claim 1, as none of the cited references teach or suggest the claimed feature of “wherein the picture image of the sender is located in at least one of a local cache on the data processing system and a preexisting database of pictures on a remote data processing system *as determined by a user selected preference*”, as described in detail hereinabove.

Applicant traverses the rejection of Claims 2-3, 9-11, 16-17 and 22 for similar reasons to those given above with respect to Claim 1.

Therefore, the rejection of Claims 1-3, 9-11, 16-17 and 22 under 35 U.S.C. § 103 has been overcome.

II. 35 U.S.C. § 103, Obviousness

Claims 5-7 and 23-24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Crawford (U.S. Patent No. 6,781,608) and Rosenblatt et al. (U.S. Patent Application Publication No. 2002/0007276), hereinafter “Rosenblatt”. This rejection is respectfully traversed.

Applicant initially traverses the rejection of Claim 5 for similar reasons given above with respect to the Claim 1 regarding the claimed feature of “*responsive to receiving* an instant message, determining whether a picture image of a sender of the instant message is associated with the instant message” that is recited in Claim 1 as well as Claim 5.

Further with respect to Claim 5, such claim recites “wherein the picture image of the sender is a selected picture that is selected from a plurality of different picture images of the sender, the selected picture being *automatically selected by the instant messaging process of the sender* based upon particular content in the instant message, wherein the picture image of the sender is a mug shot of the sender”

(emphasis added by Applicant). As can be seen, the picture image of the sender is a mug shot of the sender, and this sender mug shot is automatically selected by the instant messaging process of the sender based upon particular content in the instant message. In rejecting Claim 5, the Examiner states that the claimed automatic selection process by an instant message process is taught by Rosenblatt at paragraph 0015. It is respectfully urged that Rosenblatt does not teach (1) selection of user mug shots based on content, (2) an instant messaging process, (3) a sender-side process for performing the picture selection, or (3) selection of a mug shot by an instant message process.

As to missing claimed feature (1), the cited Rosenblatt system describes ‘virtual representations’ based on content, and these are not described as being ‘a mug shot of the sender’ as expressly recited in Claim 5. Instead, these are described as being ‘computer animations’ (page 1, paragraph [0007], lines 3-4; page 2, paragraph [0022]), which is commonly known in the art to be computer-generated pictures⁴. For example, as stated by Rosenblatt in paragraph [0022]:

“The *player module generates an image 32* of the virtual representative selected using the authoring module *and modifies this image as the text data is voiced.*”

Thus, Rosenblatt does not teach selection of user mug shots based on content.

As to missing claimed feature (2), the cited Rosenblatt does not teach an instant message process at all, but instead teaches customized modules – including an authoring module and a player module – that are used to create customized voice that is *unilaterally spoken by a virtualized speaker* (i.e. it is not a two-way instant messaging system), as described at Rosenblatt’s paragraph 0015. Rosenblatt is directed to *one-way animated applications* for web pages, email and PC games (Rosenblatt paragraph 0010), which is not a real-time two-way message exchange as is an instant messaging system, as claimed.

As to missing claimed feature (3), this Rosenblatt computer animation is generated by a ‘player module’ (page 2, paragraph [0022]), and is not done by a *sender-side* of an instant messaging process, as per the features of Claim 5. Instead, this processing occurs at a *receiver* (page 2, paragraphs [0021]-[0022]). For example, as stated by Rosenblatt in paragraph [0022]:

“This version of the player module GUI 30 is *invoked in response to an email message from a director module*, such as that illustrated in FIG. 1.”

⁴ **Computer animation** is the art of creating moving images via the use of computers. Source: <http://www.wikipedia.org>

It would not have been feasible for the Rosenblatt system to perform computer animations by the sender-side authoring module due to large amounts of communication bandwidth that would be required to send animations across a network, as Rosenblatt was keen on providing an animated system that was operable across relatively slow communication links such as a 28.8 Kbps data channel. In order to accomplish this, Rosenblatt describes that the content-based selection of images is done by the receiver and not the sender.

As to missing claimed feature (4), and for similar reasons to those given above with respect to missing claimed feature (3), the Rosenblatt content-based image is computer generated by a player module, which is different from selecting a mug shot of a sender by a sender-side instant message process, as claimed.

It is thus urged that the Examiner has failed to properly establish a prima facie showing of obviousness, as none of the cited references teach or suggest the claimed feature of “wherein the picture image of the sender is a selected picture that is selected from a plurality of different picture images of the sender, the *selected picture being automatically selected by the instant messaging process of the sender based upon particular content in the instant message*, wherein the picture image of the sender is a *mug shot of the sender*”, as described in detail hereinabove.

Applicant traverses the rejection of Claims 6-7 for similar reasons to those given above with respect to Claim 5.

With respect to Claim 23 (and dependent Claim 24), such claim is directed to a technique for sending an instant message – i.e. it is the send-side of an instant message system. This claim includes selection means and sending means. The selection means feature recites “selection means for selecting a picture image of a sender that is to be sent with the instant message, wherein the picture image of the sender is located in a preexisting database of different pictures of the sender and is automatically selected without user intervention by the selection means based upon particular content in the instant message”. None of the cited references teach such automatic selection of a sender’s picture image based upon particular content in the instant message as being a part of a *sender* instant messaging process, for similar reasons to those given above with respect to the picture selection features of Claim 5.

Therefore, the rejection of Claims 5-7 and 23-24 under 35 U.S.C. § 103 has been overcome.

III. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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